REMARKS

In the outstanding Office Action, the Examiner allowed claims 8, 14-18 and 23-25; rejected claims 1, 9, and 19 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,875,189 to Brownhill et al. ("Brownhill") in view of U.S. Patent No. 6,456,597 to Bare ("Bare"); and objected to claims 2-7, 10-13, and 20-22 as being dependent upon a rejected base claim but otherwise allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. By this amendment, claim 19 is amended to correct a minor grammatical error. Claims 1-25 remain pending.

Applicants gratefully acknowledge the Examiner's allowance of claims 8, 14-18 and 23-25, and the indication of claims 2-7, 10-13, and 20-22 as containing allowable subject matter.

Regarding the rejection of claims 1, 9, and 19 under 35 U.S.C. § 103(a), Applicants disagree with the Examiner's assertions and conclusions as set forth in the outstanding Office Action[1]. Accordingly, Applicants respectfully traverse this rejection on the ground that a *prima facie* case of obviousness has not been established. To establish a *prima facie* case of obviousness under 35 U.S.C. §103(a), each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. *See* M.P.E.P. §2143.03 8th Ed. (Rev. 2), May 2004. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of the three requirements must "be found in the prior art, and not be based on applicant 's disclosure."

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1 The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement of characterization in the Office Action.

See M.P.E.P. § 2143 8th Ed. (Rev. 2), May 2004. At a minimum, the Examiner cannot establish that the references teach each and every element of the claims or that there is motivation for combining the references in the manner the Examiner is suggesting.

Claim 1, for example, recites a combination including "indicating said multicast master entry inactive according to a comparison between the count field and the limit field." Neither Brownhill nor Bare, whether taken alone or in combination, teach or suggest at least this element.

The Examiner concedes that "Brownhill does not disclose a count field and a limit field for the multicast master entry to determine if the multicast master entry is inactive or faulty." Office Action, page 2. To attempt to cure this deficiency, the Examiner cites to Bare, stating: "Bare discloses a count field (dead count) and a limit field (dead count configured) for determining whether a network transmission port is faulty based on a comparison between the fields (col. 19, lines 38-43)." Office Action, pages 2-3. Applicants respectfully submit that the Examiner has mischaracterized Bare.

Bare teaches a "... switch-to-switch protocol for controlling switches operable in accordance with the protocol ...[for]... load balancing." Bare, col. 9, lines 3-13. A "hello packet is periodically sent out all ports ... inform[ing] the remote switch link that a load balance switch exits [sic] on the other end of the link." *Id.*, at col. 17, lines 26-29. Bare further teaches:

> ...a flags/dead count byte 510 including a dead count value in bits of hello intervals ... [wherein] ... [i]f "dead count" hello intervals go by without receiving a hello packet on a link that had previously been receiving hello packets, the load balance switch *assumes that this link is no longer in the load balance domain* and *end switches cannot be accessed* on this link.

Id., at col. 17, line 64 - col. 18, line 29 (emphasis added). Moreover, Bare teaches:

> [e]ach time a hello packet is received, the dead count is reset.
> Each time a hello packet is sent, the dead count is incremented. If

-13-

> the dead count ever exceeds the dead count configured, then the
> hello state machine goes back to the initialization state to confirm
> that *the port is no longer in the load balance domain.*

Id., at col. 19, lines 38-43 (emphasis added). Accordingly, <u>Bare</u> only teaches indicating that a port is no longer in "the load balance domain."

Regarding "the load balance domain," <u>Bare</u> teaches:

> ... [t]his is a group of switches exchanging load-balance protocol
> packets ... [a] switch is only in the domain if it sends load-balance
> protocol packets and another switch sends back load balance
> protocol packets.

Id., at col. 13, lines 44-51. <u>Bare</u> thus only teaches indicating whether a switch sends load balance protocol packets and another switch sends back load balance protocol packets. This does not constitute a teaching of "indicating said *multicast master entry inactive* according to a comparison between the count field and the limit field," as recited in claim 1 (emphasis added). Accordingly, <u>Brownhill</u> in view of <u>Bare</u> fails to teach or suggest every element recited in claim 1.

Even assuming <u>Bare</u> could be construed as teaching "indicating said multicast master entry inactive according to a comparison between the count field and the limit field," as recited in claim 1, Applicants submit that there is no motivation for combining the references in the manner suggested by the Examiner. Initially, Applicants note that <u>Brownhill</u> is directed to "a method for multicasting ATM cells," <u>Brownhill</u>, abstract, while <u>Bare</u> is directed to a "method for discovering addressing information within a network switch for an unknown MAC address" using load-balancing switch protocols. <u>Bare</u>, abstract. Since the references are directed to diverse and non-analogous arts, it would not have been obvious at the time the invention was made to have combined the teachings in a manner that would have resulted in the claimed invention. *See* M.P.E.P. § 2143.01, 8th Ed. (Rev. 2), May, 2004.

If anything, Bare teaches away from use in an ATM system as taught by Brownhill. Bare teaches that a term used therein is "different than a similar term used in Asynchronous Transmission Mode communication standards (ATM)." Bare, col. 13, lines 65-67. This statement apparently indicates that Bare is describing a method for implementation in a system other than an ATM system. Accordingly, Bare teaches away from using the method described therein in an ATM system, as proposed by the Examiner. Applicants thus submit that not only is it improper to combine references where the references teach away from their combination, *In re Grasselli*, 713 F.2d 731, 743 (Fed. Cir. 1983), but Applicants may also rebut a *prima facie* case of obviousness by showing that the prior art teaches away from the claimed invention in any material respect. *In re Geisler,* 116 F.3d at 1469 (Fed. Cir. 1997).

Furthermore, Brownhill teaches cells comprising, for example, data, cell pointers, and a count "which identifies all ports 18 the cell 14 will be sent out." Brownhill, col. 4, lines 45-60. The Examiner suggests that "it would have been obvious to one skilled in the art at the time the invention was made to have a count field and a limit field in the invention of Brownhill," without providing any suggestion or motivation in the references that Brownhill would need, or even be able to support, such a feature. Absent an impermissible hindsight reconstruction, Applicants respectfully submit that the references fail to provide any suggestion or motivation for combining the references in the manner suggested by the Examiner.

For at least the reasons presented above, Applicants submit that a *prima facie* case of obviousness has not been established. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Claims 9 and 19, although of different scope, recite elements similar to those recited in claim 1. For example, claim 9 recites a combination including "said limit field and said count

field are compared to determine an active status of one of said multicast member entries," and claim 19 recites a combination including "comparing a value in said count field with said value in said limit field to determine an active status of the connection entry." For at least the reasons given above with respect to claim 1, Applicants respectfully submit that <u>Brownhill</u> in view of <u>Bare</u> fails to teach or suggest at least these elements as well. Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 9 and 19 under 35 U.S.C. § 103(a).

Applicants respectfully request that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-7, 9-13, and 19-22 in condition for allowance. Applicants submit that the proposed amendment of claim 19 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicants' invention. It is respectfully submitted that the entering of the Amendment would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

Finally, applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the entry of this Amendment, the

Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.
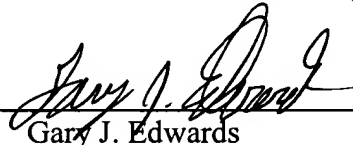
Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: November 22, 2005

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